

REMARKS

Claims 1-14 are currently pending in the subject application, and are presently under consideration. Claims 1-10 have been rejected. Claims 7-10 have been cancelled and new claims 11-14 have been added. Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. Rejection of Claims 1, 4-5, 7 and 10 Under 35 U.S.C. §102(e)

Claims 1, 4-5, 7 and 10 stand rejected under 35 U.S.C. §102(e) as being anticipated by Freeman (U.S. 6,308,266). Claims 7 and 10 have been canceled such that the rejection of these claim is now moot. Withdrawal of this rejection with respect to claims 1 and 4-5 is respectfully requested for at least the following reasons.

Claim 1 recites arranging a plurality of certificates so that a certificate having an extension which matches a selected extension is placed in a specific location in a list of said plurality of certificates. Freeman discloses a system wherein a certifying authority submits a request to a product provider for higher strength cryptography (See Freeman Col. 2, Lines 30-33). The product provider then authenticates an identity certificate contained in the request (See Freeman Col. 2, Lines 33-35). If policy considerations are met, the product provider creates a token that contains the capabilities to enable higher strength cryptography within a product (See Freeman Col. 2, Lines 40-43). However, Freeman is silent on arranging digital certificates in a specific order. Accordingly, Freeman does not disclose each and every element of claim 1. Therefore, claim 1 is not anticipated by Freeman.

Claim 4 depends from claim 1 and is not anticipated by Freeman for at least the same reasons as claim 1. Further, Freeman does not disclose that a hardware token is a smart card as recited in claim 4. Freeman discloses that a hard disk, a removable magnetic disk, a removable optical disk, magnetic cassettes, flash memory cards, digital video disks, Bernoulli cartridges, random access memories and read only memories can be used to store data (See Freeman Col. 6, Lines 13-20). However, Freeman does not disclose the use of a smart card. Moreover, none of

the media used to store data disclosed by Freeman has an integrated circuit that can store and process information like a smart card. Accordingly, Freeman does not disclose a smart card as recited in claim 4. Therefore, claim 4 is not anticipated by Freeman.

Claim 5 recites a comparator for comparing a read extension with a selected extension, and an arranger for placing a certificate in a specific location on said token accordance with the output of said comparator. Freeman discloses that the structure of an X.509 certificate contains a certificate extension (See Freeman, Col. 8, Lines 8-30). However, Freeman is silent on comparing the X.509 extension to a selected extension. Therefore, Freeman does not disclose a comparator as recited in claim 5. Further, Freeman does not disclose an arranger for placing a certificate in a specific location on a token in accordance with the output of a comparator, since Freeman is silent on arranging certificates in any specific order. Accordingly, Freeman does not disclose each and every element of claim 5. Therefore, claim 5 is not anticipated by Freeman.

For the reasons described above, claims 1 and 4-5 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 2-3, 6 and 8-9 Under 35 U.S.C. §103(a)

Claims 2-3, 6 and 8-9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Freeman (U.S. 6,308,266). Claims 8 and 9 have been canceled, such that the rejection of these claims is now moot. Withdrawal of this rejection with respect to claims 2-3 and 6 is respectfully requested for at least the following reasons.

Claim 2 depends from claim 1 and further recites that the specific location is first in said list of digital certificates. Claim 3 depends from claim 1 and further recites that the selected extension indicates a single sign-on certificate. As stated above with respect to claim 1, Freeman does not teach or suggest arranging digital certificates in any specific order. Further, as admitted in the Office Action, Freeman does not disclose the specific location is first in the list, or that the selected extension indicates a single sign-on certificate. Freeman does not make claims 2 or 3 obvious because Freeman does not teach or suggest a solution to the problem

solved by claims 2 and 3. In particular, Freeman does not address the problem wherein a particular certificate of a plurality of certificates is required to be first in a list of the certificates, for example, which is the case of a single sign-on certificate for WINDOWS® 2000 (see paragraph 31 of the specification). Additionally, Freeman does not teach or suggest a solution to this problem since the problem did not exist at the time Freeman was filed. Accordingly, Freeman does not make claims 2 or 3 obvious and therefore, claims 2 and 3 should be allowable.

Claim 6 recites the system according to claim 5, wherein the digital certificate having an extension which matches the selected extension is placed first in the list of certificates. As previously discussed with respect to claim 2, Freeman does not address the problem wherein a particular certificate of a plurality of certificates is required to be first in a list of the certificates. Accordingly, Freeman does not make claim 6 obvious, and therefore, claim 6 should be allowable.

For the reasons described above, claims 2-3 and 6 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

III. New Claims 11-14

New claims 11-14 have been added. It is respectfully submitted that new claims 11-14 are patentable over the art of record. Accordingly, Applicant respectfully requests allowance of new claims 11-14.

New claim 11 depends from claim 5 and further recites that the selected extension indicates a single sign-on certificate. As previously discussed Freeman does not teach or suggest arranging digital certificates in a specific order in which the selected extension is a single sign-on certificate.

New claim 12 recites an article comprising a storage medium having instructions stored therein, the instructions when executed causing a processing device to perform, examining an extension on a digital certificate, comparing said examined extension with a selected extension, and arranging the certificate in a specific location on said article in accordance with the results of said comparing.

Freeman does not teach or suggest comparing an examined extension with a selected extension as recited in new claim 12. Freeman discloses that the structure of an X.509 certificate contains a certificate extension (See Freeman, Col. 8, Lines 8-30). However, Freeman is silent on comparing the X.509 extension to a selected extension, as recited in new claim 11. Further, Freeman does not teach or suggest arranging a digital certificate in a specific location as recited in claim 12. Further, Freeman does not make claim 12 obvious because Freeman does not teach or suggest a solution to the problem solved by claim 12. In particular, Freeman does not address the problem wherein a particular certificate of is required to be in a specific location of an article. Accordingly, Freeman does not make claim 12 obvious and therefore, claim 12 should be allowable.

New claims 13-14 depend from claim 12 and define over the prior art for the same reasons as claim 12 and for the specific elements recited therein. Thus, claims 13-14 should be allowable.

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CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

Date 10/13/04

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